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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,469	09/26/2003	Thomas Friedrich Buncmann	090128-0306137	7396

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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/670,469	Applicant(s) BUNEMANN ET AL.	
	Examiner Cephia D. Toomer	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-31 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 20-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,693,064. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions of the present invention are suitable for use in a

Art Unit: 1714

hydraulic fluid and the compositions of the patent are hydraulic fluids containing the present compositions.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 20 and 21(i), the term –and – should be inserted after the term “di-pentaerythritol.”

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 20-25, 27 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honig (US 4,234,497).

Honig teaches a polyol ester useful as a basestock lubricant comprising one or more polyhydric alcohol, isopalmitic acid and one or more C₅-C₁₁ carboxylic acid (see abstract). It should be noted that Applicant's intended use is given no patentable weight

Art Unit: 1714

given that the claims are directed to a composition per se. The polyhydric alcohol may be neopentyl glycol, pentaerythritol, trimethylolpropane, dipentaerythritol, etc. (see col. 2, lines 47-64). The ratio of isopalmitic acid to monocarboxylic acid is from about 0.05:1 to about 1:1 (see col. 3, lines 19-22). Honig teaches that lubricants are prepared such that 90 wt% of the polyol ester is present and that the lubricants contain an additive package comprising an anti-wear agent and antioxidant (see col. 3, lines 61-68; col. 4, lines 1-4).

Honig teaches the limitations of the claims other than that the composition has a viscosity of 7000 mm²/s or less when measured at -30 °C after being held at -30 °C for 168 hours. However, no unobviousness is seen in this difference because Honig teaches polyol esters that are within the scope of the present invention and it would be reasonable to expect that the polyol ester compositions of Honig would possess similar if not the same viscosity when measured at -30 °C after being held at -30 °C for 168 hours.

8. Claims 20-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 612 831.

EP teaches a hydraulic fluid comprising a synthetic ester formed by reacting trimethylolpropane with a carboxylic acid comprising 15-85 mol% oleic acid/isostearic acid and 85 mol% or less of a C₆-C₂₂ carboxylic acid, excluding oleic and isostearic (see abstract; page 1, lines 48-54; page 2, lines 15-29). The hydraulic fluid contains a high molecular weight compound such as a polymethacrylate (functions as a viscosity index improver)(see page 4, lines 10-16). The fluid also contains additives such as

Art Unit: 1714

antioxidants, extreme pressure agents (anti-wear agents) and defoaming agents (see page 4, lines 27-40). EP teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, EP differs from the claims in that it does not specifically teach the claimed proportions. However, EP teaches that 85-15 mol% of oleic/isostearic acid is combined with 85 mol% or less of the C₆-C₂₂ acid. Given these proportions, it would have been obvious to one of ordinary skill in the art to optimize these proportions to obtain through routine experimentation for best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Furthermore, given that EP teaches that the fluid of his invention is a hydraulic fluid, it would be reasonable to expect that the hydraulic fluid of EP would possess similar if not the same viscosity when measured at -30 °C after being held at -30 °C for 168 hours.

9. Claims 20-24, 26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mancini (US 4,025,447).

Mancini teaches esters as components of lubricants wherein the esters are prepared by reacting a mixture of polyol, including trimethylolpropane and a mixture of linear alkyl monocarboxylic acids comprised of (1) one or more acids having from 7 to 8

Art Unit: 1714

carbon atoms and (ii) one or more acids having from 12 to 18 carbon atoms. The ratio of acids (i) to (ii) being from about 1.5:1 to 6:1 (see abstract; claim 3). Mancini teaches that the composition contains viscosity index improvers (see col. 5, lines 40-45).


Mancini teaches the limitations of the claims other than that the composition has a viscosity of 700 mm²/s or less when measured at -30 °C after being held at -30 °C for 168 hours. However, no unobviousness is seen in this difference because Mancini teaches polyol esters that are within the scope of the present invention and it would be reasonable to expect that the polyol ester compositions of Mancini would possess similar if not the same viscosity when measured at -30 °C after being held at -30 °C for 168 hours.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cephia D. Toomer
Primary Examiner
Art Unit 1714

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